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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,834

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Kim A. Beazley

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HOWREY LLP

C/O IP DOCKETING DEPARTMENT

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EXAMINER

KRUSE, DAVID H

ART UNIT

PAPER NUMBER

1638

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,834	<b>Applicant(s)</b> BEAZLEY ET AL.	
	<b>Examiner</b> David H. Kruse	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10, 13, 27 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 10 is/are allowed.
- 6) ☒ Claim(s) 4-6, 13, 27 and 33-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office action is in response to the Amendment and Remarks filed 15 December 2008.
2. Those objections or rejections not specifically addressed in this Office action are withdrawn in view of Applicants' amendments.
3. The Examiner acknowledges Applicants' perfection of their Deposit of Biological material, consequently the rejection under 35 U.S.C. § 112, first paragraph, for enablement as it relates to said Deposit of Biological Material is withdrawn.
4. The rejection under 35 U.S.C. § 103(a) is withdrawn in view of Applicants' arguments (page 8 of the response).
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

6. Claims 13, 27, 33 and 34 remain rejected and claims 35 and 36 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for alfalfa plant J-101 representative seed deposited with ATCC with Accession No. PTA-4814 and progeny produced therefrom comprising event J101, does not reasonably provide enablement for any glyphosate tolerant alfalfa plant comprising SEQ ID NO: 1 or 2. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. This rejection is repeated for the reason of

record as set forth in the last Office action mailed 24 July 2008. Applicant's arguments filed 15 December 2008 have been fully considered but they are not persuasive.

Applicants argue that the claimed invention can be easily practiced by skilled artisans with little or no experimentation. Applicants argue that all that is required is the acquisition of seeds containing the pMON20998 genetic event from a descendent plant or from the ATCC, where sample seeds are deposited under accession number PTA-4814. Applicants argue that determining whether or not seeds from a descendent plant carry the event is a matter of performing any number of well-known sequence analyses. gene) encoding sequences between the junctions. Applicants argue that given the availability of the claimed subject matter and the ease of detection thereof, there is no reason for skilled artisans to attempt producing the claimed alfalfa plant *de novo*, neither would skilled artisans be inclined to do so (page 6 of the Remarks). These arguments are not found to be persuasive because the instant claims do not recite that the plant comprises the pMON20998 genetic event, hence Applicants are arguing a limitation not found in the claims.

7. Claims 4-6, 13, 27 and 33-35 remain rejected and claim 36 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is repeated for the reason of record as set forth in the last

Office action mailed 24 July 2008. Applicant's arguments filed 15 December 2008 have been fully considered but they are not persuasive.

Applicants argue that skilled artisans would readily understand that this locus (the genetic locus comprising the insertion of pMON20998) can be predictably transferred from one genetic background to another by means of breeding or crossing. Indeed, the instant specification reviews this point when it states that the "invention provides a glyphosate tolerant alfalfa plant that has all of the physiological and morphological characteristics of the alfalfa event J-101 of claim 1 and the progeny plants and parts thereof" (see page 4, paragraph 1) and discloses that the locus can be inherited (see specification at page 10, line 19, though page 12, line 8). Applicants argue that certain progeny from such a cross would carry the locus in a genetic background different from each parent and would constitute other examples of alfalfa plants that embody the claim recitations (page 7 of the Remarks). These arguments are not found to be persuasive. The instant claims do not recite that the plant comprises event J-101. Hence Applicants are arguing a limitation not found in the claims.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Claims 1-3 and 10 are allowed.
10. Claims 4-6, 13, 27 and 33-35 remain rejected and claim 36 is rejected.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

/David H Kruse/  
Primary Examiner, Art Unit 1638  
10 March 2009